Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/12/2001; 2/06/2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892) ✓

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Oath/Declaration

1.   The declaration filed on 10/12/2001 is acknowledged. However, the Applicant must disclose information material to patentability under 37 C.F.R. 1.56, not a portion of 37 C.F.R. 1.56 (in this case 1.56a). See 37 C.F.R. 1.63, which states the declaration must "state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56." A new oath/declaration is required.

Drawings

3.   The drawings submitted on 2/06/2002 are acknowledged.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a " useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention,

which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine,

manufacture, process or composition of matter, which produces a concrete, tangible, and useful

result. The test for practical application is thus to determine whether the claimed invention

produces a "useful, concrete and tangible result". The claim recites a method of obtaining an

entry, analyzing a program, and generating a token. These steps do not necessarily require or

strongly suggest indisputable evidence that some hardware or tangible embodiment is being used

because these steps can be done by virtual analysis or algorithmic computations, e.g. give a

series of elementary/atomic numerical data to a calculating formula written in pseudo-code or

tabular representation done on paper to yield numeric results without the use of an computer-

based execution engine. The claim, as recited, amounts to an abstract idea failing to suggest an

application with a tangible embodiment leading to a concrete and tangible result. Thus, the

claim fails to fulfill the requirements of the practical application test and is rejected for leading to

a non-statutory subject matter.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1 – 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Fridman, U.S.

Patent 5,926,814.

In regard to claim 1:

A method for converting a software program into one or more tokens, comprising:

"obtaining one or more entries;

analyzing said source program; and

generating said tokens from said source program, wherein said entries may be used to generate a subset of said tokens."

Fridman discloses a method of converting a software program into tokens by obtaining one or more entries (in a Lexic dictionary) and analyzing the source program (column 4, lines 38 – 42), and generating tokens from the program (column 4, lines 38 – 56).

In regard to claim 2, incorporating the rejection of claim 1:

"...wherein said entries are comprise a language descriptor and a token value."

Fridman discloses matching entries in a Lexic disctionry and values for the tokens (column 4, lines 38 – 47).

In regard to claim 3, incorporating the rejection of claim 2:

"...wherein the analyzing comprises:

obtaining a lexeme from said source program; and

determining if said lexeme matches one of said language descriptors."

See Fridman column 4, lines 38 – 56.

In regard to claim 4, incorporating the rejection of claim 3:

"...wherein the analyzing further comprises:

obtaining said token value if said lexeme matches one of said language descriptors."

See Fridman column 4, lines 38 – 47.

In regard to claim 5, incorporating the rejection of claim 4:

"...wherein the analyzing further comprises:

obtaining a next lexeme from said source program."

Fridman discloses analyzing the source program generating a token after each match

(column 4, lines 45 – 47).

In regard to claim 6, incorporating the rejection of claim 5:

"...wherein the generating comprises:

outputting said token value in response to a request from a host program."

Fridman discloses outputting the token information from the dictionary to a specialist

generating an action list for a user to receive at column 4, lines 57 – 66.

In regard to claims 7 and 8, incorporating the rejection of claim 6:

"...wherein said language descriptor is a reserved word."

"...wherein said language descriptor is an operator."

Fridman discloses the use of a Lexic module to define words, identifiers, special

characters and constants. This description at least suggests that a reserved word or an operator or

any other lexical constructs are operable by the decision task creating a token as disclosed at

column 4, lines 38 – 47.

In regard to claim 9, incorporating the rejection of claim 1:

"...wherein the obtaining further comprises:

entering said token entries into a token dictionary."

Fridman discloses entering the token entries in a dictionary (column 4, lines 54 – 56).

In regard to claim 10 (a program): It is rejected for the same corresponding reasons put forth in the rejection of the method of claim 1.

In regard to claim 11 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 2.

In regard to claim 12 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 3.

In regard to claim 13 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 4.

In regard to claim 14 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 5.

In regard to claim 15 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 6.

In regard to claim 16 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 7.

In regard to claim 17(a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 8.

In regard to claim 18(a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 9.

In regard to claim 19 (a lexical analyzer): It is rejected for the same corresponding reasons put forth in the rejection of the method of claim 1.

In regard to claim 20(a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 2.

In regard to claim 21(a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 3.

In regard to claim 22 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 4.

In regard to claim 23 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 5.

In regard to claim 24 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 6.

In regard to claim 25 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 7.

In regard to claim 26 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 8.

In regard to claim 27 (a program), incorporating the rejection of claim 10: It is rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 9.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

U.S. Patent 6,715,141 to Hodge, regarding the analysis of code and generation of tokens.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lawrence Shrader whose telephone number is (703) 305-8046.

The examiner can normally be reached on M-F 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence Shrader
Examiner
Art Unit 2124

20 August 2004

TODD INGBERG
PRIMARY EXAMINER